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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/790,002

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Jerry J. Dunietz

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10/05/2006

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EXAMINER

LUDWIG, MATTHEW J

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/790,002	Applicant(s) DUNIETZ ET AL.	
	Examiner Matthew J. Ludwig	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 9-17 and 21-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9-17, and 21-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/2/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment received 7/18/2006.
2. Claims 1-5, 9-17, and 21-29, are pending in the application. Claims 1, 9, 21, and 26, are pending in the application. The terminal disclaimer filed on 7/18/2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date set by USPN 6,789,229 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 1-5, 9-17, and 21-29, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In reference to claims 1-5, 9-17, and 21-29, the claims containing a pagination method presents the manipulation of data, however, the claims fail to produce a useful, concrete, and tangible result. More specifically, the claims recite “determining a reproducible page corresponding to the selected portion based upon the hard break” and “calculating a page number corresponding to the selected portion by adding a number of pages inclusively between the reproducible page and the hard break to a sum of page counts between a plurality of hard breaks prior to and including the hard break”. Based upon the limitations found within the independent claims, the language fails to produce a useful, concrete, and tangible result.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-5, 9, 10, 16, and 17, are rejected under 35 U.S.C. 103(a) as being unpatentable over Carus et al., USPN 6,035,268 filed (8/21/1997).**

In reference to independent claim 1, Carus teaches:

The statistical analysis module examines a first segment in the stream of text to locate a first word break. The statistical analysis module, using computationally inexpensive processes, then partitions the stream of text into at least a first sub-segment and a second sub-segment divided by the first word break (compare to *“receiving an indication of a selected portion of a document that is suitable for display via a computer-based device”*). See column 3, lines 1-10.

The first and second sub-segments are then analyzed using the more computationally expensive database analysis processor to identify the remaining word breaks in the first segment (compare to *“determining a hard break in the document immediately prior to the selected portion”*). See column 3, lines 5-15.

Accordingly, the input module advantageously provides pre-processing to convert the input stream of text into a standard format, such as Unicode (compare to *“determining a reproducible page corresponding to the selected portion based upon the hard break”*). See column 5, lines 35-56.

The reference directly relates to receiving and determining hard breaks within text files and determining reproducible pages or text files based upon the selected portions of text. Carus fails to explicitly state the portion of text and the associated tags with each character in the input stream of text are directly related to a document. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to utilize the well-known input stream and tag methods of Carus and applied such methods to document streams because it would have given the author an added benefit of identifying hard breaks within document layouts utilizing similar formatting tags for improved natural language support.

In reference to dependent claim 2, Carus teaches:

The heuristic rule module also places word breaks before and after each character in the stream of text that is classified as a punctuation mark. Table 1 is a representative table that identifies whether characters in the stream of text are to be classified as punctuation marks. See column 8, lines 1-21.

In reference to dependent claim 3, Carus teaches:

The input module can also associate tags with each character in the input stream of text. The tags associated with each electronic equivalent of the characters identify attributes of the characters. See column 5, lines 50-56. Accordingly, the input module advantageously provides pre-processing to convert the input stream of text into a standard format, such as Unicode. See column 5, lines 35-56.

In reference to dependent claim 4, Carus teaches:

It is preferable to have the Japanese text represented in one standard format, such as Unicode. Accordingly, the input module advantageously provides pre-processing to convert the input stream of text into a standard format, such as Unicode. See column 5, lines 50-67.

In reference to dependent claim 5, Carus teaches:

The input module can also associate tags with each character in the input stream of text. The tags associated with each electronic equivalent of the characters identify attributes of the characters. See column 5, lines 50-56. Accordingly, the input module advantageously provides pre-processing to convert the input stream of text into a standard format, such as Unicode. See column 5, lines 35-56.

In reference to independent claim 9, Carus teaches:

The input module can also associate tags with each character in the input stream of text. The tags associated with each electronic equivalent of the characters identify attributes of the characters. See column 5, lines 50-56. Accordingly, the input module advantageously provides pre-processing to convert the input stream of text into a standard format, such as Unicode. See column 5, lines 35-56. The statistical analysis module examines a first segment in the stream of text to locate a first word break. The statistical analysis module, using computationally inexpensive processes, and then partitions the stream of text into at least a first sub-segment and a second sub-segment divided by the first word break. See column 3, lines 1-10.

In reference to dependent claim 10, Carus teaches:

The heuristic rule module also places word breaks before and after each character in the stream of text that is classified as a punctuation mark. Table 1 is a representative table that

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identifies whether characters in the stream of text are to be classified as punctuation marks. See column 8, lines 1-21.

In reference to dependent claim 16, Carus teaches:

The input module can also associate tags with each character in the input stream of text. The tags associated with each electronic equivalent of the characters identify attributes of the characters. See column 5, lines 50-56. Accordingly, the input module advantageously provides pre-processing to convert the input stream of text into a standard format, such as Unicode. See column 5, lines 35-56.

In reference to dependent claim 17, Carus teaches:

The input module either receives or generates the input stream of text that requires identification of work boundaries. The input module can either preprocess the text or it can directly transfer the stream of incoming text to the heuristic rule analysis module. See column 5, lines 35-53.

Allowable Subject Matter

7. Claims 11-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Ludwig whose telephone number is 571-272-4127.

The examiner can normally be reached on 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ML


STEPHEN HONG
SUPERVISORY PATENT EXAMINER